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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,765	12/06/2001	Lisa M. Wagner	45003-00043USPT	2046
7590	03/31/2005		EXAMINER	
Gary B. Solomon Jenkens & Gilchrist, P.C. 3200 Fountain Place 1445 Ross Avenue Dallas, TX 75202-2799			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 03/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/006,765	WAGNER ET AL.	
	Examiner	Art Unit	
	James A. Reagan	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 and 31-45 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21 and 31-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date, _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Status of Claims

1. This action is in response to the Restriction Election filed on 04 March 2005.
2. Claims 20-30 have been withdrawn.
3. Claims 1-19 and 31-45 are pending and have been examined.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

5. Claims 1, 9, 14, 15, 31, and 45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process

claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the recited steps of merely pricing classified advertisements, distributing classified advertisements, placing classified advertisements, distributing classified advertisements etc., do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed without the use of any technological apparatus, system or method such as, for example, a computer system, database, electronic circuit, or software application. These steps only constitute a method that is easily attainable without the use of any state-of-the-art devices or techniques.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a classified advertisement. Although the recited process does produce a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 9, 14, 15, 31, and 45 are deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, although claim 31 recites a method for operating an online advertising system, the limitations contained within claim 31 do not provide an advancing technological aspect.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 7 is recites the limitation "the image." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-19 and 31-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ben-Artzi et al. (WO 2000/03332 A1) in view of applicant's own admissions.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in

preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 1, 9, 14, 15 and 16:

Ben-Artzi, in at least page 2, paragraph 2 as well as other associated and relevant text clearly discloses adapting and converting electronically published classified advertisements into formats suitable for delivery and display to a variety of destination devices, thereby disclosing the following limitations:

- *receiving text of a classified advertisement from an advertiser, the classified advertisement to be provided access to at least one of a plurality of device types;*
- *substantially simultaneously formatting the text of the classified advertisement for at least two of the plurality of device types;*
- *displaying the classified advertisement as formatted for the device types;*
- *each of the plurality of text display areas represent a different output device having access to the classified advertisement.*

Ben-Artzi does not disclose:

- *determining a price for the classified advertisement as formatted for the device types; and*
- *displaying the price;*

Applicant, however, in the background of the specification, discloses pricing variables associated with placing classified advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the online publishing system of Ben-Artzi with the Applicant's admissions because the background information is considered well-known to those of ordinary skill in the art.

Claims 2, 3, 4, 6, 7, 8, 10, 11, 13:

The combination of Ben-Artzi/Applicant discloses the online classified advertisement publication system as shown above. Moreover, the limitation of receiving at least one selection for at least one of the device types to distribute the classified advertisement is considered obvious over the prior art of record because it is essential for the advertiser to choose a format.

In addition, Applicant's disclosure regarding recognized practices for publishing classified advertisement also discloses the following limitations:

- *receiving a selection for a category to place the classified advertisement;*
- *receiving a start date to begin running the classified advertisement;*
- *computing a total price based on a selection of the device types to provide access to the classified advertisement*
- *the classified advertisement includes an image;*
- *the image is a photograph;*
- *the advertiser of the advertisement includes at least one of an individual and a commercial enterprise;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the online publishing system of Ben-Artzi with the Applicant's admissions because the background information is considered well-known to those of ordinary skill in the art.

Claims 17-19:

The combination of Ben-Artzi/Applicant discloses the online classified advertisement publication system as shown above. Ben-Artzi/Applicant do not specifically disclose:

- *the different formats include a different number of characters per line;*
- *the text in each of the text display areas are individually editable;*
- *each price is based on a number of text lines in the associated text display area;*

However, the Examiner takes **Official Notice** that is old and well-known in the classified advertisement publishing arts to include these as user-specified variables because these factors are used for determining pricing for the classified advertisement.

Claims 31-34:

With regard the following limitations:

- *receiving data associated with advertisements from at least one data gathering source, the at least one data gathering source operating to publish the data to print media;*
- *storing the received data from the at least one data gathering source; and*
- *providing access to the stored received data to a plurality of device types;*
- *the advertisements are classified advertisements;*
- *converting the data from a non-content markup language to a content markup language;*
- *editing the received data;*

See Ben-Artzi, at least pages 1-2 as well as other associated and relevant text.

Claims 35 and 42:

The combination of Ben-Artzi/Applicant discloses the online classified advertisement publication system as shown above. Ben-Artzi/Applicant do not specifically disclose *said storing of the received data is performed utilizing an object oriented format*. However, the Examiner takes **Official Notice** that is old and well-known in the web-publishing arts to utilize Object Oriented formats because of the portability and reusability of the objects and classes.

Claims 36-38:

With regard the following limitations:

- *distributing the data across a network;*
- *the network is the Internet;*
- *converting the data to be distributed to a format particular to an output device;*

See Ben-Artzi, at least pages 1-2 as well as other associated and relevant text.

Claims 39-41 and 45:

With regard to the limitations of:

- *receiving a schedule for listing a classified advertisement;*
- *receiving a selection of at least one device type from a plurality of device types to provide access to the classified advertisement; and*
- *providing access to the classified advertisement to the at least one selected device type based on the schedule.*
- *the device type includes at least one of the following: personal computer, mobile phone, personal digital assistant (PDA), satellite communication device, and pager;*
- *said providing access includes distributing the classified advertisement to the at least one selected device type;*

See the citations above.

Claims 43 and 44:

With regard to the limitations of:

- *receiving a search request from a device of the selectable device types;*
- *searching for classified advertisements that satisfy the search request; and*
- *providing access to the classified advertisements that satisfy the search request to the device;*
- *the access includes enabling the classified advertisement to be listed by a search of the classified advertisements;*

See Ben-Artzi, at least Figure 5 as well as other associated and relevant text.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at **(703) 305-9768**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including

After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

28 March 2005

